

### REMARKS

Claims 1-14, 18-27, and 35-40 were pending in the present application. Claims 28-34 were previously withdrawn from consideration and Claims 15-17 were previously cancelled. Claim 40 is canceled here, and Claims 11, 13, 19, 22-26 and 38 amended. Accordingly, Claims 1-14, 18-27, and 35-38 and 40 remain under consideration. Amendment and cancellation of certain claims is not to be construed as dedication to the public of any of the subject matter of the claims as previously presented.

#### Claim Rejections

Claims 1-14, 18-27, and 35-40 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. 6,533,781 to Heim et al. ("Heim") in view of U.S. 4,590,934 to Malis et al. ("Malis").

#### Claim Amendments

The claim amendments here are not for reasons of patentability and not responsive to any rejections, but to improve the form of the claims. Claim 7 is amended to have better antecedent basis. Claims 11, 13, 19 and 22-26 and 38 are amended to improve form and clarity. The Examiner's comments about Claims 11, 13, 19 and 22-26 being directed to an intended use were taken into consideration and these claims amended accordingly.

The third independent claim, which is Claim 39, has been canceled, so now the pending independent claims are Claims 1 and 35.

#### Rejections are Traversed

The rejections of the claims are traversed. It is respectfully submitted that as indicated by the Examiner, the references do not explicitly meet the relevant features of the independent claims. The Examiner appears to have conceded this in the latest office action. Moreover, it is respectfully submitted that the references do not inherently or implicitly meet the claims, see the

enclosed Declaration. Moreover, it is respectfully submitted that the references do not make the relevant features of the independent claims obvious, see also the enclosed Declaration.

On page 3 of the Action near the bottom, the Examiner said “The ranges referred in the prior art (Heim) are the implied (they exist even though they might not be expressly mentioned) ranges of radius of curvature and pulse duration.” It is pointed out that “implied” as a matter of law is not sufficient for anticipation – the disclosure of the reference must be explicit or inherent as regards the claimed feature. It is believed that the Examiner is suggesting that the ranges referred to in the prior art inherently meet the claims. It is respectfully submitted this is not the case. There is no indication that Heim discloses or inherently has the expressed ranges of curvature or pulse duration. Moreover, the attached Declaration establishes this as a matter of fact (see paragraph 4).

In the alternative, it is understood the Examiner is saying that it would be obvious to modify the teachings of the references to meet the features of the claims. It is respectfully submitted that given the teachings of the references, it would not be obvious to do so and would not be a matter of routine experimentation to do so, contrary to what is suggested by the Examiner, also on page 3 of his Action with reference to Heim. See also the enclosed Declaration pointing this out (paragraphs 6, 7). The enclosed Declaration is by an expert in the field. He sets forth what he regards as the level of one of ordinary skill in the art. He also points why it would not be a matter of routine experimentation to arrive at the claimed features in light of the references.

The Examiner in his response to arguments on page 4 of the action applied a “capable” standard in rejecting the present claims, indicating that the references were believed capable of meeting the claimed features. It is respectfully submitted that by submission of the Declaration, it has been established that these parameters are not within the “capability” of the references, first because the references do not teach them and second there is no indication that one of ordinary skill would modify the references to meet them. In fact the references teach different features both in terms of the blade configuration and the pulse configuration. It is submitted therefore that any suggested capability of the prior art in meeting the claims has been refuted by the evidence of the Declaration.

Claim 1 Distinguishes Over the References

For the reasons set forth in the Declaration, Claim 1 clearly distinguishes over the references. There are two chief reasons for this. First, Claim 1 calls for a particular configuration of the blade cutting portion (last clause of Claim 1) being “an in-plane radius of curvature that is at least 10 times larger than said edge radius of curvature along the entire length of said cutting portion.” As established in the Declaration, this feature is not met (explicitly or inherently) or obvious in light of Heim. The Declaration further points out (paragraph 6) why it would not be obvious to modify the Heim blade to meet the limitations of Claim 1 as regards to blade.

Moreover, the claimed blade is highly advantageous in terms of enabling cutting at relatively low temperatures due to the application of relatively small amounts of electrical power. Thus the claimed blade configuration, in combination with the particular applied electrical pulses, provides a significant advantage over the prior art of the references. Lower power means less heating, but still enables a clean cut in accordance with the invention.

Additionally, Claim 1 in part (d) recites “the duration of the burst of pulses is 1 ms or less;”. As established in the Declaration (paragraph 8), this particular pulse burst is not met by Malis either explicitly or inherently and is also not obvious in light of Malis and would not be reached by routine experimentation in light of Malis. Further, it is clearly also not met by Heim.

Further as pointed out in the Declaration (paragraphs 9, 10), the claimed pulse regime effectively means a relatively short pulse burst, providing application of relatively small amounts of power per burst. In certain configurations, the duty cycle (the ratio of the time power is applied to the time power is off) is very low. A low duty cycle means less power applied overall and more time for cooling, thus less burning or charring, which is a major advantage. There is no indication that the Malis system would work with less than a 6 ms pulse burst length. Also, the claimed 1 ms or less is substantially different than in Malis (see Declaration paragraph 10). A factor of 6 is generally not a matter of routine experimentation. As pointed out in the Declaration, the Malis system would not be operative with this short a pulse burst since not enough electrical energy would

be delivered for cutting purposes (paragraph 10). Hence, not only is this structurally different than Malis, it also has a significant advantage thereover as established in the Declaration (paragraphs 11, 12).

Thus Claim 1 distinguishes over the references, as do its dependent Claims 2-14, 18-27 and 40.

#### Claim 35

Claim 35 is the other pending independent claim. Identical to Claim 1, it recites “the duration of the burst of pulses is 1 ms or less.” Hence Claim 35 distinguishes over the references as regards this feature for the same reasons as does Claim 1 and is similarly allowable. Claims 36-38 dependent upon Claim 35 are allowable for at least the same reason as the base claim.

The cancellation of Claim 39 is without prejudice, and merely to expedite prosecution.

For at least the reasons provided above, withdrawal of the rejection of Claims 1-14, 18-27, and 35-38 and 40 is respectfully requested.

**CONCLUSION**

In view of the above, all presently pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Attorney Docket No. 595992000600.

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Respectfully submitted,

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